end isolated from the interior. That aspect of the invention was not addressed in the original claims, and the effort to add a claim to it by way of reissue is not recapture of anything surrendered during original prosecution. Applicants had a right to claim this aspect of the invention, but overlooked doing so during original prosecution. Their effort to use the reissue process to add such a claim is precisely what a broadening reissue application is intended to permit. So long as the broader claim is added within two years of the original issue date, an applicant is entitled to broaden his patent to cover aspects overlooked during original prosecution. The statute limited the period of time during which such broadening could be undertaken in order to balance the harm that such broadening might cause the public against the rights of an inventor to obtain a patent for all aspects of his original invention.

As will very often be the case with an overlooked aspect of an invention, here the overlooked aspect is independent of the aspects of the invention covered by the original issued claims (1-22). Thus, quite naturally, new claim 23 does not include all of the limitations of the original claims. Since placing the connector at the periphery of the compartment is completely independent of the nature of the seal used in the electrode package, nothing about the seal being releasable or nonreleasable is included in the new claim. Instead, the new claim includes several limitations not found in the original claims, such as:

"a connector ... comprising at least one terminal and a connector body supporting the terminal";

a "connector body comprising a first end exposed to the interior of the compartment and in isclation from the external environment";

"a second end isolated from the interior of the compartment when the compartment maintains the electrode in isolation from the external environment";

"the terminal being nonunitary with the wire lead [extending to the electrode]";

the terminal "comprising a first terminal end connected to the wire lead";

the terminal comprising "a second terminal end located at the second end of the connector body".

In the last response, applicants cited *Hester Industries, Inc. v. Stein, Inc. 142 F.3d 1427, 46 USPQ2d 1641 (Fed. Cir. 1998)* as support for the principle that an applicant may overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The limitations of claim 23 outlined above are clearly of the type that the court in *Hester* had in mind when it referred to claims being materially narrower in other overlooked

aspects of the invention. They address a wholly different aspect of the invention from that addressed in the claims pursued during original prosecution.

In his most recent office action, the examiner seems to agree, as he does not challenge that the limitations are a material narrowing in other overlooked aspects. Instead what what the examiner has done is take the very surprising position that the principle articulated in *Hester* only applies when recapture is based on arguments, and not when it is based on amendments.

The examiner's position is not supported in logic or in the words of the *Hester* decision. Let's turn first to logic.

The principle that underlies the recapture doctrine is that one should not be allowed to use a reissue application to obtain claims to subject matter surrendered during original prosecution in obtaining allowance over the prior art. An applicant "surrenders" subject matter when his actions make it unmistakable that he regards the subject matter as unpatentable. The classic way in which an applicant makes such a surrender is by adding a limitation to avoid prior art, or by arguing that an existing limitation is critical to distinguishing the claim from the prior art. But whichever way he signals that he has surrendered subject matter, the outcome is the same—the subject matter cannot be later recaptured in a reissue application. Thus, one cannot in a reissue application drop the added or argued limitation, and reargue the patentability issue.

What the court reasoned in *Hester* was that an applicant that pursued an overlooked aspect, and did so by presenting a claim that was materially narrowed in that overlooked aspect, was not attempting to recapture surrendered subject matter, even though the newly presented claim dropped the limitation on which patentability had rested in original prosecution. That principle has nothing to do with the manner of the original surrender. Whether by amendment or argument, the applicant relied on a limitation for patentability, and is not entitled to a claim that merely drops the limitation. But *Hester* reasoned that if the claim was really directed at something overlooked in original prosecution—as evidenced by the claim being materially narrowed a manner relating to that overlooked aspect—then the mere fact that the new claim lacked the limitation relied on for patentability of the original claims did not mean the new claims were impermissible recapture.

Nothing in the words of the *Hester* decision supports the examiner's position. Yes, the *Hester* court refers to the type of case before it (surrender by argument) in applying the principle

of recapture not applying to claims to overlooked aspects, but it certainly does not indicate that the principle it is applying is limited to argument-based surrender. Indeed, the only reasonable reading of this section of the *Hester* decision is that the court was not formulating a new rule about overlooked aspects, but was simply deciding to apply the same principle to cases of surrender by argument. Afterall, what the Hester court did was break new ground in applying the recapture doctrine to instances where surrender was based on argument. Thus, when it came to the exception for overlooked aspects, it was simply saying that that principle, too, applied to surrender by argument. The examiner's take on the court's words is not a fair reading. Here are the court's words (the emphasis given to "by way of argument" has been retained; the court's citations to prior decisions has been deleted for brevity):

> Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. *** In the context of a surrender by way of argument, this principle, in appropriate cases may overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

Clearly, what the court was doing was applying a known principle to the new situation of surrender by way of argument, rather than developing—as the examiner would have it—a new principle applicable only to surrender by way of argument.

Accordingly, the examiner is urged to reconsider and withdraw his recapture rejection, and allow applicants to have what the reissue procedure was designed to provide—a claim to an aspect of their invention that was overlooked during original prosecution.

In closing, applicants want to repeat the reservation made in the last office action, namely, that they reserve the right to continue prosecution of the claims as originally presented in this reissue application—prior to the amendments made during prosecution of the application—should they not be successful in obtaining allowance of the claims now pending. The amendments have been made in the interest of reaching a compromise with the examiner, and are not necessary for patentability over the prior art or for meeting other requirements of the patent statute.

Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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